

REMARKS

The above amendments and following remarks are submitted within the 60 day priority period under 37 C.F.R. 1.116 in response to the Final Official Action of the Examiner mailed May 31, 2006. Having addressed all objections and grounds of rejection, claims 1-22, being all the pending claims, are now deemed in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

The Examiner has belatedly objected to the specification as containing an embedded hyperlink and/or other form of browser-executable code. Though Applicants disagree, because the objected to material is merely a format for a typical URL, the objectionable material has been removed to obviate the objection in preparation for appeal.

Claims 1-22 have been rejected under 35 U.S.C. 103(a) as being obvious over Cool ICE User's Guide Release 1.0 (hereinafter referred to as "Cool ICE") in view of U.S. Patent No. 6,094,659, issued to Bhatia (hereinafter referred to as "Bhatia"). This ground of rejection is respectfully traversed for failure of the Examiner to make a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1) motivation to make the alleged combination; 2) reasonable likelihood of success

of the alleged combination; and 3) all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

The first showing required of MPEP 2143 is that of "motivation". In her only apparent attempt at showing motivation, the Examiner states:

It would have been obvious to one of ordinary skill at the time of the invention to have combined Bhatia with Cool ICE User's Guide because Bhatia is concerned with informing a user of a failure condition through a set of predefined messages and a status message is an important message that can be implemented with a high level language for communication. (Emphasis added)

This statement is clearly erroneous. Bhatia is concerned with a "Web Server for use in a LAN Modem"¹. Therefore, the only "failure condition or other operational event" of concern to Bhatia is directly associated with the LAN Modem. The Abstract provides in part:

The resulting page informs a user stationed at the workstation of a failure condition or other operational event that then occurred at the LAN modem. (Emphasis added)

Cool ICE makes no mention of a LAN (LOCAL AREA NETWORK) or LAN modem. Therefore, Applicants strongly disagree that anyone practicing Cool ICE would have any motivation to employ a LAN or

¹See Title.

LAN modem. Such an element would be clearly superfluous to the use of Cool ICE.

Having failed to show any motivation for the alleged combination, the Examiner completely ignores her obligation to show reasonable likelihood of success. Most probably she has failed to do so because there is not reasonable likelihood of success.

MPEP 2143.03 requires that all claim limitations must be taught or suggested by the alleged combination. It reads in part:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d. 981, 180 USPQ 580 (CCPA 1974), "in judging the patentability of that claim against the prior art". *In re Wilson*, 424 F.2d 1382, 1385, 165 UPQ 494, 496 (CCPA 1970). (emphasis added)

The Examiner has failed to meet the requirement to show all claim limitations within the alleged combination, because she has at least not considered "all words in a claim" as specifically required by MPEP 2143.03.

Claim 1, for example, is limited by transferring "an unavailability message as an HTML display page to said user terminal in response to said service request when said data base management system is unavailable to receive and respond to said service request". The Examiner admits that Cool ICE does not contain this limitation. Therefore, she clearly erroneously states:

Bhatia teaches this feature.

This statement is clearly erroneous in view of the disclosure of Bhatia which has no "unavailability message", no "response to said service request", no "data base management system", and no "unavailable to receive and respond to said service request". The Examiner is respectfully reminded that MPEP 2143.03 requires "All words in a claim must be considered". Nevertheless, she has clearly ignored much of the language and therefore the basis of claim 1.

The rejection of claim 1, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to meet any of the three required showings specified by MPEP 2143.

Claim 2 depends from claim 1 and is further limited by "wherein said data base management system includes a repository for storing said unavailability message as a text file". In making her rejection, the Examiner states:

Regarding claim 2: a repository for storing said unavailability message [note: Bhatia, Figure 20 Repository of Documents (1860); col. 60 lines 17-25]

The claim specifically requires "wherein said data base management system includes a repository". Bhatia contains no "data base management system" as claimed. Therefore, the Examiner simply ignores the requirement in contravention of MPEP 2143.03 which obligates the Examiner by stating that "all words in a claim must be considered". The rejection of claim 2 is respectfully traversed for failure of the Examiner to apply MPEP 2143.03.

Claim 3 depends from claim 2 and further limits the coupling network. As explained above, the alleged combination cannot meet the limitations of claim 2 from which claim 3 depends. Therefore, the alleged combination cannot meet the further limitations of claim 3. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and is further limited by "wherein said repository includes space for storage of at least one variable for said unavailability message permitting an administrator to modify said unavailability message". Having expressly found that Cool ICE has no "unavailability message", the Examiner has somehow found that Cool ICE has the capability "permitting an administrator to modify said unavailability message". Not only is this finding clearly erroneous, it defies common logic. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the claimed data base management system. As explained above, the alleged combination cannot meet the limitations of claim 4 from which claim 5 depends. Therefore, the alleged combination cannot meet the further limitations of claim 5. The rejection of claim 5 is respectfully traversed.

Instead of examining claims 6-22, which have differing statutory and judicial bases of patentability as well as differing claim limitations, the Examiner simply states:

The limitations of claims 6-22 have been addressed above in claims 1-5, except for the following: transferring an

unavailability message to said user terminal if said determining step determines data base management system is not currently capable of honoring said service request [note: Bhatia Figure 4B; col. 7 lines 4-26 protocol may be event-specific; col. 24 lines 23-39].

In addition to this statement being legally and grammatically incorrect, to the extent understandable, it is clearly erroneous. Furthermore, the statement is legally irrelevant, because it does not address the language of any claim or limitation thereof. The Examiner is prohibited by MPEP 2143.03 from disregarding Applicants' claimed invention. The rejection of claims 6-22 is respectfully rejected as being improperly examined.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-22, as amended, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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By his attorney,



Date July 19, 2006

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